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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/485,352	03/13/2000	Michael DUPRE	2643/OG629	1819

7590

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EXAMINER

TRAN, ELLEN C

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/485,352

Applicant(s)

DUPRE, MICHAEL

Examiner

Ellen C Tran

Art Unit

2134

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 14-26.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because: No changes were made to distinguish the claimed invention from the references cited in the rejection. Also no arguments were presented, that would overcome the rejection, see below.

On page 5, the applicant notes the reference submitted were not initialed indicating that they were not reviewed, this has been corrected, and an initialed copy has been placed in the file.

On page 6, applicant "respectfully traverses the finality of the outstanding Office Action" arguing that the applicant amended the claims to correct for grammatical errors that occurred through translation. The Office disagrees the amendment to the claims significantly changed the meaning of the claimed invention. Prior to amendment the independent claim read

"A method for personalizing GSM chips, having a memory range in which at least one subscriber identification number (IMSI), and a card number ICCID are stored, and wherein for personalizing the chip an additional secret key Ki and optionally, additional data are stored wherein at the manufacturer for pre-personalizing the chip, at least initial card specific data; namely a first secret key Ki_1 and, optionally, additional data, such as PIN and PUK are stored, comprising the steps of :

after amendment the independent claim read

"A method for personalizing GSM chips, wherein at the manufacturer for per-personalizing the chip a subscriber identification number (IMSI), a card number (ICCID) and an additional secret key Ki are stored, comprising the steps of:"

The removal of the phrase "in which at least one" and the repositioning of the text further limited the claimed invention.

On page 7, the applicant requested withdrawal of the objection to amendment noted in previous office action concerning deletion of text in double brackets, objection withdrawn.

On page 8, applicant argues with respect to independent claim 19 the reference cited in the office action "is silent concerning the storing of a "subscriber identification number (IMSI) and "a card number (ICCID)", as expressed claimed" The Office disagrees the very next paragraph col. 8, lines 36-47 explains how the EEPROM 36 can store personal information such as MSN, MSI, ect".

On page 8, the applicant argues "in order to anticipate the claimed limitation, the '960 patent would have to disclose that "the chip itself derives an initial secret key Ki_1" from the chip secret key KDCOB stored in the chip by the chip manufacturer". The office disagrees the reference '960 shows how the chip itself or COB derives the an initial secret key Ki_1 in col. 13, line 40 through col. 14 line 29. The COB device generates a random number, which is sent to the controller as well as stored into RAM. Then a registration start request is initiated the carrier returns a secret key which is sent to the controller of the mobile unit, the mobile unit then sends this secret key to the COB which compares the secret key with random value to see if they match, if a match is obtained then the KECN is returned to the controller. The act of generating a random number and comparing the secret key with the integer value and the public key is the same as deriving a secret key.


On page 9, the applicant argues "the '960 patent fails to disclose the chip (i.e. the COB) as being Toolkit-enabled, nor that the chip (e.g., COB) has a component for communicating with a security center much less included in the chip for negotiating a new secret key". The office disagrees the claimed invention indicates that the "wherein the chip in the terminal equipment is Toolkit-enabled" the terminal equipment has the same meaning as the "controller of the mobile unit" like the terminal the controller of the mobile unit has a component for communicating with the security center (or carrier's terminal) '960 shows the negotiation of the secret key as shown above.

At the bottom of page 9, the applicant argues the patents '960 and '679 "fail to disclose or suggest specifically a GMS (Global System Mobile) communication system". The office disagrees in the office action it was '960 teaches a mobile communication network in col. 4, lines 6-9, in addition the term "GMS (Global System Mobile)" is shown in '679 col. 1, lines 5-18.

On page 11, the applicant argues, "This passage fails to disclose an authentication center, security center or a home location register, much less the specific limitations concerning the authentication center, security center and/or home location register". The office disagrees, the reference to "carrier's terminal" and "dealer number", in addition '960 explains in col. 21 lines 6-7 "Registration with any additional communications carrier is performed in the same sequence".

On page 11, the applicant also argues "The passage in question fails to disclose or suggest a security center, much less, that the chip (e.g., COB) and security center negotiate a new secret key Ki_2, as claims." The office disagrees patent '960 explains in col. 23, lines 45-67 which details a sequence of updating the keys.

On page 12, the applicant argues "No disabling is mention, much less those specifically enumerated in step e) of the present claimed invention". The Office disagrees the NG display means that the mobile device cannot be used with the communication network. The predetermined limit is the amount of times the mobile device can attempt to use the communication network, when this limit is reached the mobile device is disabled, see '960 col. 14, lines 1-14.


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